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WASHINGTON, DC 20005

EXAMINER

HAYES, JOHN W

ART UNIT	PAPER NUMBER
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3621

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/190,727
Filing Date: November 12, 1998
Appellant(s): PALTENGHE ET AL.

Mr. Tiep H. Nguyen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 June 2004.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Examiner agrees with appellant's statement that claims 22-24 stand or fall together for purposes of this appeal

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,794,210	Goldhaber et al	8-1998
5,987,440	O'Neil et al	11-1999
5,420,926	Low et al	5-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Goldhaber et al*, U.S. Patent No. 5,794,210 in view of *O'Neil et al*, U.S. Patent No. 5,987,440.

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As per **Claim 22**, *Goldhaber et al* disclose a method of transmitting purchase data in a database concerning a first consumer's order to at least one merchant independently of action by the first consumer comprising: storing a first data store made up of data comprising a first consumer's purchase data (Col. 6, lines 24-50); storing a second data store made up of data comprising a second consumer's purchase data (Col. 6, lines 24-50); extracting the first and second consumer's purchase data from the database (Col. 6, lines 24-61), anonymizing the purchase data into anonymous data (Col. 6, lines 27-31; 38-45; Col. 12, lines 46-53) and transmitting the anonymous data to a merchant wherein the anonymizing step is performed independently of any inputs from the consumers (Col. 13, lines 34-55). *Goldhaber et al*, however, fails to specifically disclose that the purchase data is combined with similar purchase data from a second consumer's purchase data. *O'Neil et al* disclose a system that allows a consumer to protect, command, control and process personal information and teaches combining purchase data with similar purchase data from other consumers (Col. 13 line 65-Col. 14 line 14) for the specific purpose of locating members that have expressed an interest in a certain item. It would have been obvious to one skilled in the art at the time of applicant's invention to modify the teachings of *Goldhaber et al* and include the ability to combine purchase behavior or consumer profiles of consumers with similar interests as taught by *O'Neil et al* for the advantage of identifying or locating a group of consumers for which a particular advertisement may be targeted. *Goldhaber et al* provide motivation by indicating that it is well known that advertisers have traditionally attempted to target specific groups or types of consumers based on similar interests since these consumers would be more likely to respond to the advertisement (Col. 1, lines 50-60; Col. 2, lines 22-35; Col. 3, lines 12-24).

As per **Claim 24**, *Goldhaber et al* further disclose wherein the anonymizing is performed with respect to the consumers' identification data (Col. 6, lines 38-45; Col. 7, lines 62-67).

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Goldhaber et al*, U.S. Patent No. 5,794,210 and *O'Neil et al*, U.S. Patent No. 5,987,440 as applied to claim 22 above, and further in view of *Low et al*, U.S. Patent No. 5,420,926.

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As per Claim 23, although it may have been obvious to one skilled in the art to anonymize consumers' purchase data by removing credit card numbers, the combination of *Goldhaber et al* and *O'Neil et al* fail to specifically disclose this feature. *Low et al* discloses a method for conducting anonymous credit card transactions without disclosing the details of the transaction that can be used to identify the consumer. *Low et al* teaches that it is particularly easy to assemble information about a consumer which could be used to invade an individual's privacy. For example, a credit card company or bank can use the information it acquires to determine the spending habits of a customer and can then either use that information in its own business or make it available to others. Thus, it would have been obvious to one skilled in the art to modify the methods of *Goldhaber et al* and *O'Neil et al* and anonymize the purchase data so that consumers' credit card numbers are not disclosed since this is a very effective means to identify the consumer. The specific intent of the teachings of *Goldhaber et al* are to provide consumer purchase data and consumer profile data without specifically identifying any particular consumer, therefore, it would have been obvious to remove information such as credit card numbers in view of the teachings of *Low et al*.

(11) Response to Argument

Appellant argues that claim 22 recites the combining and anonymizing steps being performed independently of any input by the first or second consumer and that the reference to *Goldhaber et al* teaches that the customer does provide inputs as to "whether or not to make [his or her contact information] available to advertisers" and that the customer "will probably want to make the [his or her] profile available while keeping [his or her] name and address secret". Appellant further asserts that *Goldhaber* teaches that members must provide inputs to preserve their anonymity and protect their privacy, wherein such inputs are actually used to determine how to handle and distribute member's personal information to other parties. Examiner respectfully disagrees and notes that *Goldhaber* discloses a database of digitally stored electronic demographic profiles of potential viewers to advertisements and further indicates that many businesses keep profiles of customer's interests and transactions by tracking the customers purchases independent of any input from the customer and

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wherein the profiles are kept private (Col. 6, lines 24-50). Goldhaber et al further teach that contact information for each member is kept confidential and if an advertiser wants a name and address for a member, he/she has to offer to buy it (Col. 12, lines 45-53). Goldhaber et al further discloses that the system will never release confidential contact information. Goldhaber et al discloses that the member may choose to release it in response to an advertiser's offer to pay for the members name and address and that there is no way that an advertiser can access this information without the member's case-by-case consent (Col. 12, lines 59-65). Examiner submits that this is further evidence that shows that the user is not required to specify or provide inputs in order to keep his/her profile anonymous. In other words, Goldhaber et al teaches that the system inherently keeps member's profiles anonymous even without any input from the user and will not release any personal or private information without specific consent by the member. Goldhaber et al further disclose that the member's profile, in addition to their contact information, is kept confidential and will never be released without the member's consent (Col. 13, lines 34-55). Members are given a chance to make this profile available to advertisers. Examiner submits that this means that members can make their profile available if they choose to do so, but this does not disclose that members are required to provide input in order to keep their profiles anonymous as applicant is asserting. Rather, Goldhaber et al teaches that the system inherently will keep members profiles confidential and anonymous even if the applicant provides no input or instructions.

Thus, examiner submits that Goldhaber et al teach that the demographic profiles are collected, stored and kept private (pseudonymous) and can be used and even marketed while protecting the customer's identity independent of any specific input from the customer. The inputs provided by the customer are used to determine how to handle or authorize the distribution of this information to other parties, but not whether or not the information is anonymized.

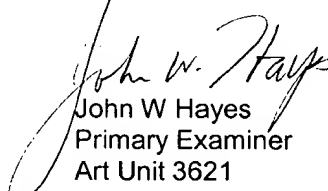
Furthermore, examiner submits that the teachings of Goldhaber et al are in close correlation with appellant's own disclosure. For example, appellant's disclosure indicates that the system includes a server that stores an information bank of different types of personal data such that the information may be used by the consumer and institutions which the consumer has authorized to access the data (Page 3, lines 4-7). Appellant's disclosure further indicates that the information bank may store dynamic demographic information data about the consumer and that consumers who allow use and transmission

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of this data to others such as merchants could be paid a portion of receipts of selling that data received by an institution such as a bank (Page 4, lines 10-19). Appellant's disclosure further indicates that it is optimal for the financial institution to maintain principal possession, maintenance and storage of the consumers information for consumer authorized use and distribution, while simultaneously achieving, without the introduction of yet another party, the securing of the consumer's personal information in an "information bank" (Page 4, lines 24-29). Thus, these passages in appellant's disclosure suggest that the consumer does provide inputs in order to authorize the use and distribution of the consumer's data, substantially the same way as that taught by Goldhaber et al. Again, the inputs taught by Goldhaber et al are provided by the consumer in order to instruct the system as to how the consumer would like the information to be distributed (similar to appellant's disclosure), however, these inputs are not required in order to keep the consumers information anonymous.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


John W Hayes
Primary Examiner
Art Unit 3621

September 2, 2004

Conferees

James Trammell, SPE 3621 

John Weiss, SPE 3629  9-2-04

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